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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,430	08/27/2003	Martin Novil	01-0045/COA	5196

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FREUDENBERG-NOK GENERAL PARTNERSHIP
LEGAL DEPARTMENT
47690 EAST ANCHOR COURT
PLYMOUTH, MI 48170-2455

EXAMINER	
PICKARD, ALISON K	
ART UNIT	**PAPER NUMBER**
3673	

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/649,430	NOVIL ET AL.	
	Examiner	Art Unit	
	Alison K. Pickard	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-19,31 and 32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-12,14-19 and 31* is/are rejected.

7)☒ Claim(s) *13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raden (6,409,178).

Raden discloses a cylinder head gasket having a flat body 26 with a hole and an encapsulant (e.g. 74 or 78) coating the first and second sides and the hole. The encapsulant can be colored (i.e. has a pigment) (see col. 6, lines 35-56). Raden does not disclose that the color has brightness above 75 on a CIE LAB system. It is not considered inventive to discover the workable or optimum ranges by routine experimentation absent the showing of criticality for such ranges. See In re Aller, 105 USPQ 233, 235 (CCPA 1955). Further, it is known that gaskets can be "light" colored as evidenced by the Garlock sheet and Botrie. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the gasket with an encapsulant having a color with brightness above 75 on a CIE LAB system.

3. Claims 1, 2, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant-Acquah (6,237,919).

Grant-Acquah discloses a cylinder head gasket having flat body with a hole and encapsulant 30 on both sides and the hole. The encapsulant, an epoxy, can contain a pigment. Grant-Acquah does not disclose that the color has brightness above 75 on a CIE LAB system. It

is not considered inventive to discover the workable or optimum ranges by routine experimentation absent the showing of criticality for such ranges. See In re Aller, 105 USPQ 233, 235 (CCPA 1955). Further, it is known that gaskets can be "light" colored as evidenced by the Garlock sheet and Botrie. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to make the gasket with an encapsulant having a color with brightness above 75 on a CIE LAB system.

4. Claims 3, 4, 5, 16, 17, 18, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grant-Acquah as applied to claims 1, 2, and 14 above, and further in view of Itoh (4,714,733).

Grant-Acquah does not disclose the pigments used in the coating. Itoh teaches that titanium dioxide, zinc oxide, and coloring agents (i.e. pigment blue 15 or green 7) are known pigments used to create "any light color" (see abstract) in a rubber used in gaskets (col. 6, lines 25-38). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the pigments taught by Itoh to achieve the desired color of the encapsulant.

5. Claims 6, 7, 15, and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Raden as applied to claims 1 and 14 above, and further in view of Inamura (6,517,084).

Raden does not disclose a topcoat. Inamura teaches using a silicone (inherently clear) coating on the entire surface of a gasket (even over other coatings) to absorb tool marks, etc. and provide durability and resistance (col. 4, lines 51-61). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the gasket of Raden with a silicone coating as taught by Inamura to improve the gasket sealing ability.

6. Claims 9, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raden as applied to claim 1 in view of Itoh in view of Inamura.

Raden does not disclose the pigments used in the coating. Itoh teaches that titanium dioxide, zinc oxide, and coloring agents (i.e. pigment blue 15 or green 7) are known pigments used to create "any light color" (see abstract) in a rubber used in gaskets (col. 6, lines 25-38). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the pigments taught by Itoh to achieve the desired color of the encapsulant. Raden does not disclose a topcoat. Inamura teaches using a silicone (inherently clear) coating on the entire surface of a gasket (even over other coatings) to absorb tool marks, etc. and provide durability and resistance (col. 4, lines 51-61). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the gasket of Raden with a silicone coating as taught by Inamura to improve the gasket sealing ability.

Allowable Subject Matter

7. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

It is known to make gaskets of varying colors. For example, both Raden and Grant-Acquah disclose a colored cylinder head gasket. And, Raden, Jeanne, Yamada, and Garlock teach the use of a color as an indicator for properties, positioning, assembly, etc. Further, Itoh, Botrie, and Wilson teach well known pigments (i.e. such as titanium dioxide) to provide a desired color such as white. One of ordinary skill would have the knowledge to select any color, including light colors, as the indicating color used with the gasket. Further, one of ordinary skill would have the knowledge of various pigments (i.e. such as titanium dioxide) that can be used to achieve that color. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alison K. Pickard
Primary Examiner
Art Unit 3673

AP